

#4
Pre-Amer

Practitioner's Docket No. D1077+11

PATENT

ADDED PAGES FOR APPLICATION TRANSMITTAL WHERE BENEFIT OF
PRIOR U.S. APPLICATION(S) CLAIMED

NOTE: See 37 CFR 1.78.

17. Relate Back

WARNING: If an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. 120, 121 or 365(c), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. 120, 121 or 365(c). (35 U.S.C. 154(a)(2) does not take into account, for the determination of the patent term, any application on which priority is claimed under 35 U.S.C. 119, 365(a) or 365(b).) For a c-i-p application, applicant should review whether any claim in the patent that will issue is supported by an earlier application and, if not, the applicant should consider canceling the reference to the earlier filed application. The term of a patent is not based on a claim-by-claim approach. See Notice of April 14, 1995, 60 Fed. Reg. 20,195, at 20,205.

(complete the following, if applicable)

☒ Amend the specification by inserting, before the first line, the following sentence:

A. 35 U.S.C. 119(e)

NOTE: "Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number)." 37 C.F.R. § 1.78(a)(4).

☒ "This application claims the benefit of U.S. Provisional Application(s) No(s):

APPLICATION NO(S):

FILING DATE

<u>60 / 091.887</u>	<u>07/07/1998</u>	"
<u>60 / 095.626</u>	<u>08/07/1998</u>	"
<u>60 / 098.907</u>	<u>09/02/1998</u>	"

B. 35 U.S.C. 120, 121 and 365(c)

NOTE: "Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. . . . Cross-references to other related applications may be made when appropriate." (See § 1.14(a)). 37 C.F.R. § 1.78(a)(2).

☒ "This application is a

[] continuation

[X] continuation-in-part

[] divisional

of copending application(s)

[X] application number 09 / 077,337 filed on 05/27/1998 "

[X] International Application PCT/US97/21422 filed on 11/25/1997
and which designated the U.S."

NOTE: The proper reference to a prior filed PCT application that entered the U.S. national phase is the U.S. serial number and the filing date of the PCT application that designated the U.S.

NOTE: (1) Where the application being transmitted adds subject matter to the International Application, then the filing can be as a continuation-in-part or (2) if it is desired to do so for other reasons then the filing can be as a continuation.

NOTE: The deadline for entering the national phase in the U.S. for an international application was clarified in the Notice of April 28, 1987 (1079 O.G. 32 to 46) as follows:

"The Patent and Trademark Office considers the International application to be pending until the 22nd month from the priority date if the United States has been designated and no Demand for International Preliminary Examination has been filed prior to the expiration of the 19th month from the priority date and until the 32nd month from the priority date if a Demand for International Preliminary Examination which elected the United States of America has been filed prior to the expiration of the 19th month from the priority date, provided that a copy of the international application has been communicated to the Patent and Trademark Office within the 20 or 30 month period respectively. If a copy of the international application has not been communicated to the Patent and Trademark Office within the 20 or 30 month period respectively, the international application becomes abandoned as to the United States 20 or 30 months from the priority date respectively. These periods have been placed in the rules as paragraph (h) of § 1.494 and paragraph (i) of § 1.495. A continuing application under 35 U.S.C. 365(c) and 120 may be filed anytime during the pendency of the international application."

[X] "The nonprovisional application designated above, namely application
09 / 077,337, filed 05/27/1998, claims the benefit of
U.S. Provisional Application(s) No(s):

APPLICATION NO(S):

FILING DATE

60 / 031,956	11/27/1996	"
/		"
/		"

[] Where more than one reference is made above please combine all references into one sentence.

18. Relate Back—35 U.S.C. 119 Priority Claim for Prior Application

The prior U.S. application(s), including any prior International Application designating the U.S., identified above in item 17B, in turn itself claim(s) foreign priority(ies) as follows:

Country	Appln. no.	Filed
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The certified copy(ies) has (have)

☐ been filed on _____, in prior application 0 / _____, which was filed on _____.

☐ is (are) attached.

WARNING: *The certified copy of the priority application that may have been communicated to the PTO by the International Bureau may not be relied on without any need to file a certified copy of the priority application in the continuing application. This is so because the certified copy of the priority application communicated by the International Bureau is placed in a folder and is not assigned a U.S. serial number unless the national stage is entered. Such folders are disposed of if the national stage is not entered. Therefore, such certified copies may not be available if needed later in the prosecution of a continuing application. An alternative would be to physically remove the priority documents from the folders and transfer them to the continuing application. The resources required to request transfer, retrieve the folders, make suitable record notations, transfer the certified copies, enter and make a record of such copies in the Continuing Application are substantial. Accordingly, the priority documents in folders of international applications that have not entered the national stage may not be relied on. Notice of April 28, 1987 (1079 O.G. 32 to 46).*

19. Maintenance of Coadependency of Prior Application

NOTE: *The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the continuation application. Notice of November 5, 1985 (1060 O.G. 27).*

A. ☐ Extension of time in prior application

(This item must be completed and the papers filed in the prior application, if the period set in the prior application has run.)

☐ A petition, fee and response extends the term in the pending **prior** application until _____.

☐ A copy of the petition filed in prior application is attached.

B. ☐ Conditional Petition for Extension of Time in Prior Application

(complete this item, if previous item not applicable)

☐ A conditional petition for extension of time is being filed in the pending **prior** application.

☐ A copy of the conditional petition filed in the prior application is attached.

20. Further Inventorship Statement Where Benefit of Prior Application(s) Claimed

(complete applicable item (a), (b) and/or (c) below)

- (a) ☐ This application discloses and claims only subject matter disclosed in the prior application whose particulars are set out above and the inventor(s) in this application are

☐ the same.

- ☐ less than those named in the prior application. It is requested that the following inventor(s) identified for the prior application be deleted:

(type name(s) of inventor(s) to be deleted)

- (b) ☒ This application discloses and claims additional disclosure and a new declaration or oath is being filed. With respect to the prior application, the inventor(s) in this application are

☐ the same.

- ☒ the following additional inventor(s) have been added:

Robert E. Usner, Glenda K. Griswald, Omar El-Kaissi, James Church

(type name(s) of inventor(s) to be added)

- (c) ☒ The inventorship for all the claims in this application are

☒ the same.

- ☐ not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made

☐ is submitted.

☐ will be submitted.

21. Abandonment of Prior Application *(if applicable)*

- ☐ Please abandon the prior application at a time while the prior application is pending, or when the petition for extension of time or to revive in that application is granted, and when this application is granted a filing date, so as to make this application copending with said prior application.

NOTE: According to the Notice of May 13, 1983 (103, TMOG 6-7), the filing of a continuation or continuation-in-part application is a proper response with respect to a petition for extension of time or a petition to revive and should include the express abandonment of the prior application conditioned upon the granting of the petition and the granting of a filing date to the continuing application.

22. Petition for Suspension of Prosecution for the Time Necessary to File an Amendment

WARNING: *"The claims of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or a substitute for, an earlier application, and (2) all the claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds of art of record in the next Office action if they had been entered in the earlier application." MPEP, § 706.07(b).*

NOTE: *Where it is possible that the claims on file will give rise to a first action final for this continuation application and for some reason an amendment cannot be filed promptly (e.g., experimental data is being gathered) it may be desirable to file a petition for suspension of prosecution for the time necessary.*

(check the next item, if applicable)

- ☐ There is provided herewith a Petition To Suspend Prosecution for the Time Necessary to File An Amendment (New Application Filed Concurrently)

23. Small Entity (37 CFR § 1.28(a))

- ☐ Applicant has established small entity status by the filing of a statement in parent application / _____ on _____.
- ☐ A copy of the statement previously filed is included.

WARNING: *See 37 CFR § 1.28(a).*

24. NOTIFICATION IN PARENT APPLICATION OF THIS FILING

- ☐ A notification of the filing of this
(check one of the following)
- ☐ continuation
- ☐ continuation-in-part
- ☐ divisional

is being filed in the parent application, from which this application claims priority under 35 U.S.C. § 120.

16. Instructions as to Overpayment

NOTE: "... Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account." 37 CFR 1.26(a).

☐ Credit Account No. _____.

☐ Refund



SIGNATURE OF PRACTITIONER

Reg. No. 31,029

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(type or print name of practitioner)

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06217436160

☒ **Incorporation by reference of added pages**

(check the following item if the application in this transmittal claims the benefit of prior U.S. application(s) (including an international application entering the U.S. stage as a continuation, divisional or C-I-P application) and complete and attach the ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED)

☒ Plus Added Pages for New Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed

Number of pages added 5

☐ Plus Added Pages for Papers Referred to in Item 4 Above

Number of pages added _____

☐ Plus added pages deleting names of inventor(s) named on prior application(s) who is/are no longer inventor(s) of the subject matter claimed in this application.

Number of pages added _____

☐ Plus "Assignment Cover Letter Accompanying New Application"

Number of pages added _____

☐ **Statement Where No Further Pages Added**

(if no further pages form a part of this Transmittal, then end this Transmittal with this page and check the following item)

☐ This transmittal ends with this page.